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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Bridon *et al.*

Confirmation No.: 7359

Application No.: 10/722,733

Art Unit: 1648

Filed: November 25, 2003

Examiner: Zachariah Lucas

For: LONG LASTING SYNTHETIC
GLUCAGON LIKE PEPTIDE (GLP-1)Attorney Docket No.: 11767-055-999
(CAM: 515319-999055)

**REQUEST FOR RECONSIDERATION OF
DECISION ON PETITION UNDER 37 C.F.R. § 1.182**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants received from the United States Patent and Trademark Office (“USPTO”) a Decision on Petition Under 37 C.F.R. § 1.182 dated September 2, 2008 (“Decision”), dismissing Applicants’ Petition Under 37 C.F.R. § 1.182 filed on June 30, 2008 (“the June 30, 2008 Petition”), which requested that the above-identified abandoned application be amended to recite the correct relationship to a prior-filed application to which priority is claimed under 35 U.S.C. § 120. Applicants hereby request reconsideration of the USPTO’s Decision and reiterate their request that U.S. Patent Application No. 10/722,733 (“the ’733 Application”) be so amended. In particular, Applicants seek to amend the ’733 application to indicate that the ’733 application is a continuation-in-part, rather than a continuation, of prior-filed U.S. Patent Application No. 09/623,548 (“the ’548 Application”).

The Decision states that a petition under 37 C.F.R. § 1.78(a)(3) is required in order to amend the ’733 Application to indicate the correct relationship to the ’548 Application. Applicants respectfully disagree. A petition under 37 C.F.R. § 1.78(a)(3) is necessary where a claim for the benefit of a prior-filed application under 35 U.S.C. 120, 121 or 365(c) is unintentionally delayed. Applicants respectfully submit that a petition under 37 C.F.R. § 1.78(a)(3) is not necessary in the instant case because a claim for the benefit of priority to the ’548 Application, though not indicating the correct relationship between the ’733 Application

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and the '548 Application, was nonetheless included in both the Application Data Sheet (provided as Exhibit 2 with the June 30, 2008 Petition) and Preliminary Amendment (provided as Exhibit 3 with the June 30, 2008 Petition) filed concurrently with the '733 Application on November 25, 2003, and was recognized by the USPTO as shown by its inclusion on a filing receipt for the '733 Application. Thus, the claim for benefit of priority to the '548 Application was timely submitted in accordance with 37 C.F.R. 1.78(a)(2)(ii). M.P.E.P 201.11 (V) (page 200-69, Eighth Edition, Revision 5, August 2006) states in relevant part:

If an applicant includes a claim to the benefit of a prior application elsewhere in the application but not in the manner specified in 37 CFR 1.78(a)(2)(i) and (a)(2)(iii) or 37 CFR 1.78(a)(5)(i) and (a)(5)(iii) (e.g., if the benefit claim is included in an unexecuted oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a)(2)(ii) or (a)(5)(ii), the Office will not require a petition and the surcharge under 37 CFR 1.17(t) to correct the benefit claim if the information concerning the benefit claim contained elsewhere in the application was recognized by the Office as shown by its inclusion on a filing receipt.

As discussed in the June 30, 2008 Petition, the filing receipt of the '733 application, dated March 15, 2004 (provided as Exhibit 1 with the June 30, 2008 Petition), indicates that the domestic priority data for the '733 application, as claimed by Applicants, are the following (emphasis added):

This application is a CON of 10/288,340 11/04/2002
which is a DIV of 09/657,332 09/07/2000 PAT 6,514,500
which claims benefit of 60/159,783 10/15/1999
This application 10/722,733
is a CON of 09/623,548 09/05/2000
which is a 371 of PCT/US00/13576 05/17/2000
which claims benefit of 60/159,783 10/15/1999
and claims benefit of 60/153,406 9/10/1999
and claims benefit of 60/134,406 05/17/1999.

Thus, the benefit claim to the '548 application was recognized by the USPTO, as shown by inclusion of the benefit claim to the '548 application on the filing receipt for the '733 application.

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Since the claim for benefit of priority to the '548 application was timely submitted and recognized by the USPTO, a petition under 37 C.F.R. § 1.78(a)(3) is not necessary merely to correct the information provided in the priority claim. M.P.E.P 201.11 (V) (page 200-70, Eighth Edition, Revision 5, August 2006) states in relevant part:

A petition under 37 CFR 1.78(a)(3) and the surcharge would not be required for correcting a timely submitted benefit claim for the following situations:

(A) Changing the relationship of the applications (e.g., changing from "continuation" or "divisional" to "continuation-in-part" or from "continuation-in-part" to "continuation" or "divisional"); ...

Since Applicants seek to amend the '733 application to change the relationship of the applications from continuation-in-part to continuation, *i.e.*, to indicate that the '733 application is a continuation-in-part rather than a continuation of the '548 application, pursuant to M.P.E.P 201.11, a petition under 37 CFR 1.78(a)(3) is not necessary.

In view of the foregoing, Applicants request reconsideration of the USPTO's decision on the June 30, 2008 Petition, and reiterate their request to amend the '733 application to correct the priority claim to the '548 application, and for entry of the Supplemental Application Data Sheet submitted with the June 30, 2008 Petition. Applicants emphasize that amendment of an abandoned application to correct a priority claim is proper under *Sampson v. Commissioner of Patents and Trademarks*, 195 U.S.P.Q. 136 (D.D.C. 1976), and is properly petitionable under 37 C.F.R. § 1.182 (*see* the June 30, 2008 Petition, page 3).

Applicants believe that no fee is due for this request. Should any fee be required, however, please charge such fee to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

Date: October 30, 2008


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Since the claim for benefit of priority to the '548 application was timely submitted and recognized by the USPTO, a petition under 37 C.F.R. § 1.78(a)(3) is not necessary merely to correct the information provided in the priority claim. M.P.E.P 201.11 (V) (page 200-70, Eighth Edition, Revision 5, August 2006) states in relevant part:

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Since Applicants seek to amend the '733 application to change the relationship of the applications from continuation-in-part to continuation, *i.e.*, to indicate that the '733 application is a continuation-in-part rather than a continuation of the '548 application, pursuant to M.P.E.P 201.11, a petition under 37 CFR 1.78(a)(3) is not necessary.

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